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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,179	06/29/2000	Yuan Chang	45185-CA/JPW/SHS	1263

7590 08/24/2005  
John P White  
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EXAMINER

LAMBERTSON, DAVID A

ART UNIT PAPER NUMBER

1636

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No. 09/607,179	Applicant(s) CHANG ET AL.
Examiner David A. Lambertson	Art Unit 1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 22 July 2005.
- 2a)  This action is FINAL.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 52 and 53 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 52 and 53 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submissions filed on July 22 and January 21, both of 2005, have been entered.

Claims 52 and 53 are pending and under examination in the instant application. Any rejection of record that is not discussed further has been withdrawn.

Applicant's arguments with respect to claim 52 and 53 have been considered but are moot in view of the new ground(s) of rejection. The new rejection is necessitated by the current amendment of the claims.

### *Priority*

Applicant's claim for domestic priority to US 08/343,101 (now US Patent 5,830,759) under 35 U.S.C. 120 is acknowledged. However, the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 52-53 of this application. Specifically, SEQ ID NO: 14 is not disclosed in this priority application. As such, priority is granted only to April 4, 1995 (US Application 08/420,235, now US Patent 5,801,042), wherein instant SEQ ID NO: 14 is disclosed in its entirety.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 52 is rejected under 35 U.S.C. 102(b) as being anticipated by Josephs *et al.* (*J. Virol.* **65**: 5597-5604, 1991; see entire document; henceforth Josephs).

Claim 52 is construed as a polypeptide. The polypeptide must first be encoded a nucleic acid. This nucleic acid must be at least 30 nucleotides in length, and must comprise a portion of SEQ ID NO: 14. Since SEQ ID NO: 14 is a nucleic acid sequence that comprises adenine, any nucleic acid that is at least 30 nucleotides long and has at least one adenine residue meets the limitations of the nucleic acid. The polypeptide must also be recognized by an antibody that recognizes a protein that is encoded by a herpesvirus associated with Kaposi's sarcoma (KS). Herpesvirus-6 (HSV-6) is known to be associated with KS; therefore, a nucleotide sequence that is at least 30 nucleotides long and has at least one adenine, and which encodes an HSV-6 polypeptide, meets the limitations of the claim. Claim 53 merely reads on a composition comprising the polypeptide of claim 52, along with a carrier (which can be water, or virtually any other material).

Josephs teaches the identification of the Glycoprotein H protein from HSV-6 (see for example the Abstract and Figure 2). This protein was 694 amino acids in length (encoded by a nucleotide sequence of 2094 nucleotides in length) (see for example page 5600, right column), and thus represents a protein encoded by a nucleotide sequence of over 30 nucleotides in length

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that contains at least one adenine residue, and wherein said encoded protein is recognized by an antibody that detects proteins encoded by herpesvirus associated with KS. As such, Joseph anticipates the invention as claimed.

Claims 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu *et al.* (*Virology* 197: 12-22, 1993; see entire document; henceforth Liu).

Liu teaches the production of the HSV-6 Glycoprotein H, and its interaction with an antibody (see for example the Abstract and Figure 1). Because the HSV-6 Glycoprotein H represents a protein encoded by a nucleotide sequence of over 30 nucleotides in length and containing at least one adenine residue, and wherein said encoded protein is recognized by an antibody that detects proteins encoded by herpesvirus associated with KS, Liu anticipates both the claimed protein and a composition comprising said protein.

***Allowable Subject Matter***

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.  
AU 1636



JAMES KETTER  
PRIMARY EXAMINER